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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/030,962

Applicant(s)

KIRBY, JOHN KENNETH

Examiner

Patricia L. Nordmeyer

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12, 22-24, 26, 28-33 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 22-24, 26 and 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 32, 33 and 38-42 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I, claims 1 – 12, 22 – 24, 26 and 28 – 31 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Specification*

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “wherein the planar layers comprise card” in claims 6 and 8 is unclear, which render the claims vague and indefinite. It is unclear what material is being called card. For the purposes of examination, “card” is taken to mean “cardboard”.

Correction/clarification is required.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 7, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fetherston et al. (USPN 3,995,984).

Fetherston et al. disclose planar tiles of molded plastic on respective sides of a core material (Column 3, lines 45 – 49) made of the same material, resin impregnated materials (Column 3, lines 56 – 60). The molded plastic is made from laminated multi-layers of the resin impregnated material (Column 3, lines 52 – 55). Three layers of resin impregnated material form the planar tiles of the article (Column 4, lines 57 – 68 and Figure 10, #66, 68, 70 and 72).

Regarding the “respective faces of a planar layer integrated therewith during injection molding of the tile” in claim 1, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable

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even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of attachment of the planar layers due to injection molding is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

7. Claims 1 – 3 and 7 – 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Auken (USPN 4,065,150).

Van Auken discloses laminar planar tiles of molded plastic made of polypropylene foam material (Column 5, lines 12 – 14) to form a laminated article (Figure 5). The molded plastic is made from laminated multi-layers of the foam articles and fiber reinforced layers (Column 5, lines 7 – 11).

Regarding the “respective faces of a planar layer integrated therewith during injection molding of the tile” in claim 1, the determination of patentability for a product-by-process claim

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is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of attachment of the planar layers due to injection molding is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

8. Claims 1, 2, 5, 6, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Roberts (USPN 3,940,528).

Roberts discloses rigid planar tiles of molded plastic (Column 25, line 63 and Column 26, lines 34 – 36) made of a similar material, a plastic material (Column 26, lines 18 – 29 and Column 26, lines 34 – 39). A rigid reinforcement layer of paper chipboard or cardboard (Column 19, lines 24 – 30) is adhered to the rear surface of the planar material (Column 26, lines

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49 – 52). The top surface of the facing layer is textured during the molding of the tile (Column 26, lines 13 – 16).

Regarding the “respective faces of a planar layer integrated therewith during injection molding of the tile” in claim 1 and the “planar layers being textured by the mould during moulding” in claim 24, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of attachment of the planar layers due to injection molding and the texture being formed during moulding are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

9. Claims 1 – 5, 7 – 9 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Altshuler et al. (USPN 6,132,844).

Altshuler et al. disclose a backing of rigid planar tiles of molded plastic (Column 11, lines 7 – 25) made of laminates of polymeric film or paper (Column 11, lines 37 – 40) chosen from oriented polypropylene film (Column 12, lines 5 – 13). A layer of non-slip particles is adhered to the surface of the backing layer with a coating of adhesive material (Column 3, lines 53 – 54 and column 4, lines 32 – 45).

Regarding the “respective faces of a planar layer integrated therewith during injection molding of the tile” in claim 1, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of attachment of the planar layers due to injection molding is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).



***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 10 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altshuler et al. (USPN 6,132,844).

Altshuler et al. disclose a backing of rigid planar tiles of molded plastic (Column 11, lines 7 – 25) made of laminates of polymeric film or paper (Column 11, lines 37 – 40) chosen from oriented polypropylene film (Column 12, lines 5 – 13). A layer of non-slip particles is adhered to the surface of the backing layer with a coating of adhesive material (Column 3, lines 53 – 54 and column 4, lines 32 – 45).

Altshuler et al. disclose the claimed invention except for the planar layers each comprising three laminae and the planar layers each comprise three laminae of oriented polypropylene. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have multiple layers of oriented polypropylene with three laminae, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Altshuler et al. disclose the claimed invention except for the planar layers each comprise a lamina of paper provided between the laminae of oriented polypropylene. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place piece of paper between the laminae of the oriented polypropylene, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

12. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Altshuler et al. in view of West (USPN 4,376,812).

Altshuler et al. disclose a backing of rigid planar tiles of molded plastic (Column 11, lines 7 – 25) made of laminates of polymeric film or paper (Column 11, lines 37 – 40) chosen from oriented polypropylene film (Column 12, lines 5 – 13). A layer of non-slip particles is adhered to the surface of the backing layer with a coating of adhesive material (Column 3, lines 53 – 54 and column 4, lines 32 – 45). However, Altshuler et al. fails to teach a mat with a screen printed coating.

West teaches an ink transferred coating (Figure 2, #22 and Column 3, lines 43 – 45) on the surface of a decorative laminate (Column 2, lines 60 – 65) for the purpose of creating a more pleasing surface for the user and increased abrasion resistance (Column 7, lines 44 – 49).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the ink transferred coating in Altshuler et al. in order to create a more pleasing surface for the user and increased abrasion resistance as taught by West.

13. Claims 28 – 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altshuler et al. in view of Cordani (USPN 5,834,104).

Altshuler et al. disclose a backing of rigid planar tiles of molded plastic (Column 11, lines 7 – 25) made of laminates of polymeric film or paper (Column 11, lines 37 – 40) chosen from oriented polypropylene film (Column 12, lines 5 – 13). A layer of non-slip particles is adhered to the surface of the backing layer with a coating of adhesive material (Column 3, lines 53 – 54 and column 4, lines 32 – 45). However, Altshuler et al. fails to teach a non-slip backing material attached to the laminar mat, the backing being attached by an adhesive and the adhesive being heat activated.

Cordani teaches a non-slip backing material (Column 6, lines 27 – 28) attached to the back of a sheet using a thermally activated adhesive (Column 6, lines 14 – 16 and 20 – 23) in a laminated mat (Figure 3) for the purpose of forming a mat that is used on a variety of different surfaces in order to protect and which will not move when placed under stress by the user.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the non-slip surface attached by a thermally activated

adhesive in Altshuler et al. in order to form a mat that is used on a variety of different surfaces in order to protect and which will not move when placed under stress by the user as taught by Cordani.

14. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Altshuler et al. in view of Cordani as applied to claims 28 – 30 above, and further in view of Kubota (USPN 4,500,373).

Altshuler et al., as modified with Cordani, disclose a backing of rigid planar tiles of molded plastic (Column 11, lines 7 – 25) made of laminates of polymeric film or paper (Column 11, lines 37 – 40) chosen from oriented polypropylene film (Column 12, lines 5 – 13) with a non-slip backing adhered to the back surface. However, the modified Altshuler et al. fail to teach a layer of aluminum foil between the planar laminar layer and the heat sensitive adhesive material.

Kubota teaches a layer of aluminum foil (Column 5, lines 5 – 6 and Figure 4 – 6, #5) as a substrate (Column 4, line 65) for the purpose of giving strength to the laminated decorative sheets.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the layer of aluminum foil in Altshuler et al. in order to give strength to the laminated decorative sheets as taught by Kubota.

**Conclusion**

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 4,339,489 to Barker et al., U.S. Patent 4,093,766 to Scher et al. and U.S. Patent 3,373,068 to Grosheim et al are cited to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

June 10, 2003

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772* *6/13/03*